

REMARKS/ARGUMENTS

Claims 1-32 are pending.

Claims 2, 8-14, 16, 22-28, 30 and 32 are withdrawn from consideration.

Claims 1, 3-7, 15, 17-21, 29 and 31 are rejected.

Claims 1, 15, 29 and 31 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

35 USC §102(b) REJECTION

Claims 1, 6, 15, 20, 29 and 31 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,846,125 to Robichon.

The Applicants respectfully traverse the 35 USC §102(b) rejection of claims 1, 6, 15, 20, 29 and 31.

The law is clear that anticipation requires that a single prior art reference disclose each and every limitation of the claim sought to be rejected. 35 U.S.C. 102(b).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. § 112 ¶ 4.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 1 to recite, among other things, a rotary edging wheel for rough cutting of an optical lens, comprising: (1) a hub portion operable for attachment to a rotary power source, wherein said hub portion includes a substantially solid body member; (2) an outer circumferential rough cutting surface having a width, wherein said surface is adjacent to said body member, said surface including an abrasive grit attached thereto, wherein said abrasive grit is operable for rough cutting of the optical lens; and (3) at least one pair of substantially adjacent swarf clearing grooves formed in said surface, comprising: (a) a first swarf clearing groove extending at an angle across said surface; and (b) a second swarf clearing groove extending at an angle across said surface, wherein said first and

second swarf clearing grooves are angled either towards each other or away from each other and extend continuously across said surface; wherein said first and second swarf clearing grooves are operable to remove swarf during a rough cutting operation of the optical lens.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 15 to recite, among other things, a rotary edging wheel for polishing of an optical lens, comprising: (1) a hub portion operable for attachment to a rotary power source, wherein said hub portion includes a substantially solid body member; (2) an outer circumferential cutting surface having a width, wherein said surface is adjacent to said body member, said surface including an abrasive grit attached thereto, wherein said abrasive grit is operable for polishing of the optical lens; and (3) at least one pair of substantially adjacent swarf clearing grooves formed in said surface, comprising: (a) a first swarf clearing groove extending at an angle across said surface; and (b) a second swarf clearing groove extending at an angle across said surface, wherein said first and second swarf clearing grooves are angled either towards each other or away from each other and extend continuously across said surface; wherein said first and second swarf clearing grooves are operable to remove swarf during a polishing operation of the optical lens.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 29 to recite, among other things, a method for rough cutting of an optical lens, comprising: (1) providing an edging wheel, comprising: (a) a hub portion operable for attachment to a rotary power source, wherein said hub portion includes a substantially solid body member; (b) an outer circumferential rough cutting surface having a width, wherein said surface is adjacent to said body member, said surface including an abrasive grit attached thereto, wherein said abrasive grit is operable for rough cutting of the optical lens; and (c) at least one pair of substantially adjacent swarf clearing grooves formed in said surface, comprising: (i) a first swarf clearing groove extending at an angle across said surface; and (ii) a second swarf clearing groove

extending at an angle across said surface, wherein said first and second swarf clearing grooves are angled either towards each other or away from each other and extend continuously across said surface, wherein said first and second swarf clearing grooves are operable to remove swarf during a rough cutting operation of the optical lens; (2) selectively rotating said edging wheel; and (3) bringing the optical lens into selective contact with said rotating edging wheel.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 31 to recite, among other things, a method for polishing of an optical lens, comprising: (1) providing a rotary edging wheel, comprising: (a) a hub portion operable for attachment to a rotary power source, wherein said hub portion includes a substantially solid body member; (b) an outer circumferential cutting surface having a width, wherein said surface is adjacent to said body member, said surface including an abrasive grit attached thereto, wherein said abrasive grit is operable for polishing of the optical lens; and (c) at least one pair of substantially adjacent swarf clearing grooves formed in said surface, comprising: (i) a first swarf clearing groove extending at an angle across said surface; and (ii) a second swarf clearing groove extending at an angle across said surface, wherein said first and second swarf clearing grooves are angled either towards each other or away from each other and extend continuously across said surface, wherein said first and second swarf clearing grooves are operable to remove swarf during a polishing operation of the optical lens; (2) selectively rotating said edging wheel; and (3) bringing the optical lens into selective contact with said rotating edging wheel.

Robichon teaches no such structure or methodology, as recited in claims 1, 15, 29 and/or 31.

Specifically, Robichon fails to teach a hub portion including a substantially solid body member. In fact, Robichon teaches the opposite, i.e., a hub portion having a series of fluid passages formed in a body member thereof. Robichon also fails to teach the use of swarf clearing grooves, i.e., the grooves taught by Robichon are not intended to remove swarf, but

rather are intended to ensure uniform cooling fluid distribution (see column 3, lines 35-41) for high temperature metal grinding applications. Robichon is designed for metal cutting operations with lubricant or coolant, not for cutting polymer lens materials which applicant's wheel is designed to do, without the necessity of radial coolant holes such as taught by Robichon. Robichon is non-analogous art which teaches away from the present invention.

Accordingly, the Applicants submit that claims 1, 15, 29 and 29 are allowable over Robichon.

Because claims 1 is allowable over Robichon, claims 3-7, which further define claim 1, are likewise allowable. Because claim 15 is allowable over Robichon, claims 17-21, which further define claim 15, are likewise allowable.

Furthermore, the Applicants submit that Robichon does not render claims 1, 3-7, 15, 17-21, 29 and 31 obvious.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested

modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

As previously noted, Robichon fails to suggest a hub portion including a substantially solid body member. In fact, Robichon teaches the opposite, i.e., a hub portion having a series of fluid passages formed in a body member thereof. Robichon also fails to suggest the use of swarf clearing grooves, i.e., the grooves taught by Robichon are not intended to remove swarf, but rather are intended to ensure uniform cooling fluid distribution (see column 3, lines 35-41) for high temperature metal grinding applications. In fact, the presence of any significant amount of cooling fluid such as oil, would probably interfere with the removal of any swarf, even if it was present, due to presumed caking and clumping of the resulting mixture. Furthermore, Robichon is directed to high temperature grinding operations, hence the need for the cooling fluid and passages for delivering the same, whereas the present invention is directed towards low temperature rough cutting and polishing operations for lens materials, wherein swarf removal is the primary concern. Thus, one of ordinary skill in the art would not look to Robichon for guidance on constructing a rotary edging wheel for rough cutting or polishing of an optical lens, as presently claimed.

35 USC §103(a) REJECTION

Claims 3-5 and 17-19 stand rejected under 35 USC §103(a) as being unpatentable by U.S. Patent No. 5,846,125 to Robichon.

The Applicants respectfully traverse the 35 USC §103(a) rejection of claims 3-5 and 17-19.

As previously noted, Robichon does not suggest any such structure as recited in independent claims 1 or 15.

Specifically, Robichon fails to suggest a hub portion including a substantially solid body member. In fact, Robichon teaches the opposite, i.e., a hub portion having a series of fluid

passages formed in a body member thereof. Robichon also fails to suggest the use of swarf clearing grooves, i.e., the grooves taught by Robichon are not intended to remove swarf, but rather are intended to ensure uniform cooling fluid distribution (see column 3, lines 35-41) for high temperature metal grinding applications.

Because claim 1 is allowable over Robichon, claims 3-5, which further defines claim 1, are likewise allowable. Because claim 15 is allowable over Robichon, claims 17-19, which further defines claim 15, are likewise allowable.

35 USC §103(a) REJECTION

Claims 7 and 21 stand rejected under 35 USC §103(a) as being anticipated by U.S. Patent No. 5,846,125 to Robichon in view of U.S. Patent No. 6,047,278 to Wu et al.

The Applicants respectfully traverse the 35 USC §103(a) rejection of claims 7 and 21.

As previously noted, Robichon does not suggest any such structure as recited in independent claims 1 and/or 15.

The recitation of Wu does not cure the deficiencies in the teachings of Robichon. While Wu may arguably suggest that cubic boron nitride and diamond are well known superabrasives, it does not suggest the use of swarf clearing grooves whatsoever, least of all as presently claimed. Accordingly, one of ordinary skill in the art would not look to Robichon or Wu, either alone or in combination therewith, for guidance on constructing a rotary edging wheel for rough cutting or polishing of an optical lens, as presently claimed.

Accordingly, the Applicants submit that claims 1 and 15 are allowable over Robichon and Wu, either alone or in combination therewith.

Because claim 1 is allowable over Robichon and Wu, either alone or in combination therewith, claim 7, which further defines claim 1, is likewise allowable. Because claim 15 is allowable over Robichon and Wu, either alone or in combination therewith, claim 21, which further defines claim 15, is likewise allowable.

CONCLUSION

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by the Examiner in the Office Action of April 13, 2005 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 501612. A duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

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